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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,950	01/15/2002	Henry F. McIntyre	9D-EC-19976/064853-040	4820

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EXAMINER	
O CONNOR, GERALD J	

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/047,950	McIntyre et al.	
	Examiner	Art Unit	
	O'Connor	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *THREE* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *October 7, 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) *none* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *January 15, 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *20041025*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Preliminary Remarks

1. This Office action responds to the amendment and arguments filed by applicant on October 7, 2004 in reply to the previous Office action, mailed June 25, 2004.

2. The amendment of claim 13 by applicant in the reply filed October 7, 2004 is hereby acknowledged.

Oath/Declaration

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it does not *correctly* identify the specification to which the oath or declaration is directed. See MPEP § 601.01(a).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art, as described in the written description of the specification.

As described by applicant in the written specification, the instant invention is merely a method of using conventional, well known computer equipment in order to implement and effect an automated method for accomplishing the same well known results as had heretofore been accomplished via manual means (such as those described, for example, in the Background of the Invention, on pages 1-3 of the written specification).

As such, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the conventional manual method of managing information pertaining to the transport of a product between a point of origin and a point of destination, so as to make use of well known, conventional equipment, including barcodes, barcode scanners, and various computers loaded with appropriate software, the barcode scanners and other computers being any of portable, non-portable, or handheld, in order to derive the claimed features of the instant invention, the motivation to make the modifications being simply to improve the efficiency of

the information management process pertaining to the transport of a product between a point of origin and a point of destination by reducing the amount of manual effort required, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results, and since it has been held that simply providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Response to Arguments

6. Applicant's arguments filed October 7, 2004 have been fully considered but they are not persuasive.

7. Regarding the argument that the declaration is acceptable with the wrong application number because the error was merely due to carelessness by applicant, the declaration is not acceptable with the wrong application number on it. Applicant's arguments would carry some weight if there were no application number at all on the declaration, but since applicant entered an application number, and signed a declaration averring the veracity of all the information contained therein (including the application number), the Office cannot accept a mere statement by applicant's attorney that any of the information in the declaration is anything different than was stated therein. Therefore, a corrected declaration, properly identifying the application to which it is directed, is indeed required. Applicant should take care that all of the information entered in the substitute declaration is indeed truthful and accurate.

8. Regarding the argument that the instant invention is not simply a computerization of an old method performed manually, as evidenced by the many disadvantages of the prior art manual method that have now been overcome by the computerization provided by the invention, even an ingenious application of known principles to known problem by use of devices already known and understood to produce predictable result does not amount to invention. Moreover, the fact that an invention may produce a more efficient and more economical method of accomplishing result does not constitute invention. *Barrott et al. v. The Drake Casket Company*, 127 USPQ 69.

Furthermore, applicant acknowledges (last paragraph of page 13 of the reply) that the various elements of computerization are all well known elements, and, notably, fails to mention any new functionality performed by the invention other than simply performing the conventional process using the well known computer elements. Note that steps such as "managing information" were indeed necessarily, thus inherently, performed by the underlying known manual method, even if such steps were not explicitly described by applicant with respect to the conventional process.

9. Regarding the argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 170 USPQ 209 (CCPA 1971).

10. Regarding the argument that a rejection cannot be based on applicant's disclosure because such basis would comprise improper hindsight, applicant's disclosure comprises two elements: disclosure of prior art, and disclosure of the instant invention. The later of these cannot be used as a basis for the rejection, as that would indeed constitute improper hindsight. However, the former of these two elements, applicant's disclosure of the prior art known to applicant at the time of the invention, can certainly be used properly as the basis for a prior art rejection.

When applicant states that something is prior art, it is taken as being available as prior art against the claims. Moreover, admitted prior art can indeed be used in obviousness rejections. *In re Nomiya*, 509 F.2d 566, 184 USPQ 607, 610 (CCPA 1975). See MPEP § 2129.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to the disclosure.

12. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is (703) 746-3976.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is (703) 308-1113.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at (703) 308-5183.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC
January 10, 2005

(1-10-05)

Gerald J. O'Connor
Patent Examiner
Group Art Unit 3627